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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,679	02/12/2001	Charles E. Hunter	WT-15	6129

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EXAMINER

RAMAN, USHA

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/781,679

Applicant(s)

HUNTER ET AL.

Examiner

Usha Raman

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 41-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Arguments***

1. Applicant's arguments filed April 6<sup>th</sup>, 2005 have been fully considered but they are not persuasive. Applicant argues that Ginter does not disclose the step transmitting distributor content identification from a remote viewing location upon playback of a digital content. The examiner respectfully disagrees. Ginter discloses the step of identifying content and distributor information from a remote viewing location to a clearing house for the purpose of charging the viewer for the playback of the content as well as compensating the distributor. See [0989], and [1022].

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 41-56, 59-76, 79-84, 98-111 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (US Pre Grant Pub. 20040054630).

In regards to claims 41 and 108, Ginter discloses a method comprising:

Playing recorded data at a remote viewing location (the system comprises a media player therefore has the capability of playing a media content, see [0450])

Receiving from the remote viewing location, information identifying the recorded data and at least one distribution agent for the recorded data. See [0989] and [1022].

In regards to claims 42 and 81 the distribution agent (publishing house) makes copies of the digital recorded data delivered to the distribution agent. See [0380] and [0388].

In regards to claims 43, 63, 72, 82 and 102, the receiving act comprises receiving information at the system operator location (clearinghouse) from playback devices (end users), the information identifying the recorded data and the distribution agents. See [0989] and [1022].

In regards to claims 44, 62, 83, 101, 109 and 110, Ginter discloses receiving (metering) information at the system operator location at defined times. See [0146].

In regards to claims 45, 84 and 111, Ginter discloses the step of receiving information at the system operator location indicating each time the recorded data is played. See Ginter [0376].

In regards to claims 46 and 85, Ginter discloses the step of charging the consumer based on the information received at the system operator location. See [0388]

In regards to claims 47, 74, 86 and 103, Ginter discloses the step of charging the consumer a fee for each time the consumer plays the recorded data. See [0376]

In regards to claims 48 and 87, Ginter discloses a flexible metering scheme where a user can be charged each time a content is played or a user can be charged a single fee for accessing a content is played or a user can be charged a single fee for accessing a content unlimited times during a certain time duration.

The user is charged a variable fee for accesses during that subscribed time duration and a pay per play fee for accessing outside that subscription period. See [1083].

In regards to claims 49 and 88, Ginter discloses:

The distribution agent is a retail store. See [0010], and [0257]

The consumer obtains identified copies of the recorded data at retail stores [0257] and subsequently returns the identified copies to the retail stores (i.e. user rents content object). See [1004], [2071].

In regards to claims 51, 65 and 90, Ginter discloses the step of compensating the distribution agent for each time the recorded data distributed by the agent is paid. See [0376], [0388], and [1022]. 0256?

In regards to claims 52 and 91, Ginter discloses the step of charging the distribution agent for recordings delivered to the distribution agent. See [0256], [0378]

In regards to claims 53, 69, 79, 92 and 107, Ginter discloses providing an identified group of playback devices with specified processor (the VDE electronic appliances running rights operating system) to enable the identified group of playback devices to play the distributed recorded data and thereby to inhibit playback devices other than the identified group of playback devices from playing the distributed data. See [0458] and [0459].

In regards to claim 54, 93, and 99, Ginter discloses that the recorded data includes a multitude of data frames having a specified security code (i.e. rules and

controls security code) and the specified processor only outputs data frames having the specified security code. See [0414].

In regards to claims 55 and 94, the digital data is recorded in a tangible medium and the tangible medium is a digital video disk. See [0147]

In regards to claims 56, 67, 76 and 95 and 105, the digital data is recorded in a tangible medium and the tangible medium is an optical disc. See [0147].

In regards to claims 60 and 100, Ginter discloses a system for distributing recorded digital data comprising:

Distribute to a consumer a copy from a multitude of sets of copies of digital data recording (see [0257]), where the copies in each set include data identifying an associated distribution agent (see [0416], [0989] and [1022]).

Distribute a playback device to the consumer for playing the copy of recording, the playback device comprising an identification mechanism configured to identify contents of and the distribution agent associated with the copy of the recording. See [0450], [1022].

A transmitting mechanism configured to transmit from the playback device to a system operator location information identifying the contents of and the distribution agent associated with the copy of the recording played by the playback device. See [0989] and [1022].

In regards to claims 61, 71 and 73, Ginter discloses a receiving mechanism located at the system operator configured to receive the information from the

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playback device and for using the information to determine compensation for the content provider and the distribution agents. See [0376], [0388], [1022].

In regards to claims 64, Ginter discloses that the distribution network includes a plurality of retail stores. See [0010] and [0257].

In regards to claims 66, 75 and 104, the playback device includes a specified circuit (VDE electronic appliances with rights operating system) that enables the playback device to play distributed copies of the recording. See [0458], [0459].

In regards to claims 68 and 106, the recorded digital data is a movie. See [0062].

In regards to claim 70, Ginter discloses a system for playing and for monitoring the playing of digital recordings having given content authorization by a content provider, each of the recordings including data identifying an associated distribution agent, the system comprising:

At least one playback device for playing the recordings, the at least one playback device including an identification mechanism configured to identify the distribution agents associated with the recordings. See [0450] and [1022];

A system controller configured to receive from the at least one playback device, information identifying the distribution agents associated with the recordings played by the playback device. See [0989] and [1022].

In regards to claim 80, Ginter discloses the method of comprising the step of, each time a recorded data is played at a remote viewing location, receiving from the

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remote viewing location at a system operator location, information identifying the recorded data and the distribution agent for the recorded. See [0989] and [1022].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 50 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Pre Grant Pub. 2004/0054630) in view of Knight (US Pat. 6,243,350).

In regards to claims 50 and 89, Ginter does not disclose the step of distributing the recorded data to the consumer at no charge.

Knight (6,243,350) teaches the step of distributing a plurality of movies to a user on a cartridge for free, wherein the user may obtain access the movies on the disk after making some type of payment. See column 58, lines 40-59.

It would have been obvious to one of ordinary skill in the art to modify the system by distributing a disk comprising a plurality of movies to the user at no charge, and receive payments only when a movie is played. The motivation is to let the user obtain a library of movies at no charge, while charging the user only when content is used.



6. Claims 57, 77 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Pre Grant Pub. 2004/0054630) in view of Yuen et al. (US Pat. 6,147,715).

In regards to claims 57, 77 and 96, Ginter does not disclose the step of providing the consumer with guides for identifying the multitude of copies of recorded data possessed by the consumer.

Yuen (6, 147, 715) discloses the step of providing a guide (TIG) for identifying the plurality of recordings that are recorded in a storage medium. See abstract.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by providing guide to identify the multitude copies of recorded data on a medium possessed by the consumer. The motivation is to provide an on screen navigation directory for guiding the user with program selection.

In regards to claims 58, 78 and 97, the system does not comprise the step of transmitting data to update the information in guides.

Examiner takes official notice that it is well known to transmit information for updating guides.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by transmitting information to update the guides, in order to provide the user with the latest up to date information regarding the programs.

7. Claims 58, 78, and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Pre Grant Pub. 2004/0054630) in view of Yuen et al. (US Pat. 6,147,715) and as applied to claim 57 and 96 above, and further in view of Ward et al. (US Pre Grant Pub. 2005/0010949).

In regards to claims 59 and 98, the system does not disclose the step of updating guides with commercials based on the consumer's viewing of the played copies of digital data.

Ward et al. discloses the step of updating guides with commercials based on consumer's viewing habits, including played programs. See abstract, [0090], [0091] and [0306].

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system in view of Ward's teachings by updating commercials in the program guide based on consumer's viewing of played copies of digital data. The motivation is to provide the consumers with advertisements that fit their viewing profile, thereby providing them advertisements they are likely to have interested in.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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